

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(PCT Rule 71.1)

To:

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Date of mailing
(day/month/year)

18.10.2005

Applicant's or agent's file reference
no reference

IMPORTANT NOTIFICATION

International application No.
PCT/FI2004/000427

International filing date (day/month/year)
06.07.2004

Priority date (day/month/year)
07.07.2003

Applicant
PIRILÄ, Hannu et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary report on patentability and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international
preliminary examining authority:



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PATENT COOPERATION TREATY
PCT
INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)
(PCT Article 36 and Rule 70)

Applicant's or agent's file reference no reference	FOR FURTHER ACTION		See Form PCT/PEA/416																								
International application No. PCT/FI2004/000427	International filing date (day/month/year) 06.07.2004	Priority date (day/month/year) 07.07.2003																									
International Patent Classification (IPC) or national classification and IPC H04Q7/22, H04L12/28																											
Applicant PIRILÄ, Hannu et al.																											
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p style="margin-left: 20px;">a. <input checked="" type="checkbox"/> sent to the applicant and to the International Bureau) a total of 3 sheets, as follows:</p> <p style="margin-left: 40px;"><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p style="margin-left: 40px;"><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p style="margin-left: 20px;">b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>																											
<p>4. This report contains indications relating to the following items:</p> <table style="width: 100%; border: none;"><tr><td style="width: 10%;"><input checked="" type="checkbox"/></td><td style="width: 15%;">Box No. I</td><td>Basis of the opinion</td></tr><tr><td><input type="checkbox"/></td><td>Box No. II</td><td>Priority</td></tr><tr><td><input type="checkbox"/></td><td>Box No. III</td><td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td></tr><tr><td><input type="checkbox"/></td><td>Box No. IV</td><td>Lack of unity of invention</td></tr><tr><td><input checked="" type="checkbox"/></td><td>Box No. V</td><td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td></tr><tr><td><input type="checkbox"/></td><td>Box No. VI</td><td>Certain documents cited</td></tr><tr><td><input type="checkbox"/></td><td>Box No. VII</td><td>Certain defects in the international application</td></tr><tr><td><input type="checkbox"/></td><td>Box No. VIII</td><td>Certain observations on the international application</td></tr></table>				<input checked="" type="checkbox"/>	Box No. I	Basis of the opinion	<input type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input type="checkbox"/>	Box No. VIII	Certain observations on the international application
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Date of submission of the demand 27.12.2004		Date of completion of this report 18.10.2005																									
Name and mailing address of the international preliminary examining authority:  European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016		Authorized Officer Weinmiller, J Telephone No. +31 70 340-3884																									

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**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/FI2004/000427

Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

Description, Pages

1-7 as originally filed

Claims, Numbers

1-17 received on 20.12.2004 with letter of 20.12.2004

Drawings, Sheets

1/2-2/2 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing
3. ☒ The amendments have resulted in the cancellation of:
- ☐ the description, pages
 - ☒ the claims, Nos. 1-17
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify)*:
 - ☐ any table(s) related to sequence listing *(specify)*:
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify)*:
 - ☐ any table(s) related to sequence listing *(specify)*:

* If item 4 applies, some or all of these sheets may be marked "superseded."

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/FI2004/000427

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-17
Inventive step (IS)	Yes: Claims	
	No: Claims	1-17
Industrial applicability (IA)	Yes: Claims	1-17
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

**INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY
(SEPARATE SHEET)**

International application No.

PCT/FI2004/000427

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

Reference is made to the following document/s/:

- D1: EP-A-1 076 463 (LUCENT TECHNOLOGIES INC) 14 February 2001 (2001-02-14)
- D2: WO 98/59513 A (NOKIA MOBILE PHONES LTD ; LINTULAMPI RAINO (FI)) 30
December 1998 (1998-12-30)
- D3: WO 98/53626 A (ERICSSON TELEFON AB L M) 26 November 1998 (1998-11-26)

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of independent claims 1, 6; 12, 15 is not new in the sense of Article 33(2) PCT.

Method for use in a network device, comprising the steps of: the network device supporting the first mode (see D1, column 4, line 5-7), receiving service request signalling from a multimode terminal (see D1, column 4, line 17-18) for requesting any service that the terminal supports in at least one of the various modes supported by the terminal (see D1, column 4, line 17-19) but which is not supported by the receiving network device or by the multimode terminal in the serving mode (see D1, column 4, line 16-17), characterized in that the network device is a network element of the multimode network (see D1, Fig. 1).

The applicant argues novelty of the invention over D1, D2 and D3. However most of the claimed features of the invention are not present in the claims. The arguments are therefore irrelevant. The applicant is reminded that the subject of the application is the invention as defined in the claims. In particular the claims do not define any registration aspects.

Furthermore the method claims 1 and 6 merely comprise a single step, namely receiving/sending a service request which a terminal could use but the current network cannot offer. Quite obviously this step is known, see D1 in the above passages; D2, page 6, line 3-8. There are no features in the claims directed to what processes are performed after the request is received. Any further properties which are claimed for the invention are mere interpretation lacking basis in the claims.

The applicant is further pointed to the fact that a plurality of terms are comprised which lack

**INTERNATIONAL PRELIMINARY
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any clear meaning. E.g. it is not clear what "the first mode" is as neither modes are defined nor does the term have any antecedent basis. The same applies to "service" which is too broad to translate into technical features. The amendment made to the claim comprises a further such deficiency in that it describes "the multimode network" which has no antecedent basis. The naming of "the network device" being a "network element" is a mere choice of terminology and does not relate to any technical properties of the method.

The same reasoning applies, *mutatis mutandis*, to the subject-matter of the corresponding independent claims 6, 12 and 15, which therefore are also considered not new/inventive.

Dependent claims 2-5, 7-11, 13, 14, 16, 17 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step, see documents D1, D2 and D3 and the corresponding passages cited in the search report.

CLAIMS

1. Method for use in a network device, comprising the steps of:
the network device supporting the first mode, receiving service request signalling from a multimode terminal for requesting any service that the terminal supports in at least one of the various modes supported by the terminal but which is not supported by the receiving network device or by the multimode terminal in the serving mode,
characterized in that the network device is a network element of the multimode network.
2. A method according to claim 1 where the network device decides to move the terminal to another system, supporting a second mode and the requested service, the second mode and the requested service in the second mode also being supported by the multimode terminal, if possible and necessary in order to establish the requested service.
3. A method according to claim 1, characterised in that the network device is using service request signalling messages that as such are used for services supported in the first mode, but using signalling parameter code points indicating a specific service that is not supported by the network device or by the multimode terminal in the first mode but the specific service being supported by another system operating in the second mode.
4. A method according to claim 1, characterised in that the service request signalling is triggered by a mobile station originated service establishment request.
5. A method according to claim 1, characterised in that the service request signalling is triggered by a network originated service establishment request.
6. Method for use in a multimode terminal device, comprising the steps of:
the multimode terminal device sending service request signalling to a network device operating in the first mode, for requesting any service that the terminal supports in at least one of the various modes supported by the terminal but which is not supported by the receiving network device or by the multimode terminal in the serving mode,
characterized in that the network device is a network element of the multimode network.
7. A method according to claim 6, where the terminal device is moved to another system, supporting a second mode and the requested service, the second mode and the requested service in

the second mode also being supported by the multimode terminal, if possible and necessary in order to establish the requested service.

8. A method according to claim 6, characterised in that the multimode terminal device is using service request signalling messages that as such are used for services supported for the first mode, but using code points indicating a specific service that is not supported in the first mode, either by the multimode terminal or by the network operating in the first mode.

9. A method according to claim 6, characterised in that the multimode terminal device is using service request signalling that is not known by the network operating in the first mode and where the service request from the terminal is then forwarded by the network operating in the first mode, in a transparent container, to the network operating in a second mode, the second mode being also supported by the terminal, the network supporting the second mode decoding the service request and initiating a service based handover towards the network operating in the second mode where the requested service can be established.

10. A method according to claim 6, characterised in that the service request signalling is triggered by a mobile station originated service establishment request.

11. A method according to claim 6, characterised in that the service request signalling is triggered by a network originated service establishment request.

12. A Multimode terminal comprising means for sending service request signalling to a network device operating in the first mode, for requesting any service that the terminal supports in at least one of the various modes supported by the terminal but which is not supported by the receiving network device or by the multimode terminal in the serving mode,
characterized in that the network device is a network element of the multimode network.

13. A multimode terminal according to claim 12, where the terminal device is moved to another system, supporting a second mode and the requested service, the second mode and the requested service in the second mode also being supported by the multimode terminal, if possible and necessary in order to establish the requested service.

14. A multimode terminal according to claim 12, where the multimode terminal device is using service request signalling messages that as such are used for services supported for the first

mode, but using code points indicating a specific service that is not supported in the first mode, either by the multimode terminal or by the network operating in the first mode.

15. A network device supporting first mode, comprising means for receiving service request signalling from a multimode terminal for requesting any service that the terminal supports in at least one of the various modes supported by the terminal but which is not supported by the receiving network device or by the multimode terminal in the serving mode, characterized in that the network device is a network element of the multimode network.

16. A network device according to claim 15 where the network device decides to move the terminal to another system, supporting a second mode and the requested service, the second mode and the requested service in the second mode also being supported by the multimode terminal, if possible and necessary in order to establish the requested service.

17. A network device according to claim 15, where the network device is using service request signalling messages that as such are used for services supported in the first mode, but using signalling parameter code points indicating a specific service that is not supported by the network device or by the multimode terminal in the first mode but the specific service being supported by another system operating in the second mode.